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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.          | CONFIRMATION NO. |
|---|-------------|----------------------|------------------------------|------------------|
| 10/635,805  | 08/05/2003  | Jean Rapin           | 10945.105003 (Neuro<br>102US | 9760             |
| 20786   | 7590        | 12/20/2005           | EXAMINER                     |                  |
| KING & SPALDING LLP<br>191 PEACHTREE STREET, N.E.<br>45TH FLOOR<br>ATLANTA, GA 30303-1763 |             |                      | CORDERO GARCIA, MARCELA M    |                  |
|   |             |                      | ART UNIT                     | PAPER NUMBER     |
|   |             |                      | 1654                         |                  |

DATE MAILED: 12/20/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |  |                                     |  |
|------------------------------|--|-------------------------------------|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/635,805         | <b>Applicant(s)</b><br>RAPIN ET AL. |  |
|                              | <b>Examiner</b><br>Marcela M. Cordero Garcia | <b>Art Unit</b><br>1654             |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on November 9, 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,2 and 5-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 5-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 9, 2005 has been entered.

This Office Action is in response to the reply received on November 9, 2005.

Claims 1-2 and 5-8 are pending in the application.

Any rejection from the previous office action, which is not restated here, is withdrawn.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-2 and 5-8 are presented for examination on the merits.

For the art rejection below, please note that “neurodegenerative disease”, as evidenced by Aizenman et al. (US 5,091,391. See e.g., column 3, lines 33-41) means “a physical condition which has caused or may cause degradation of portion of a subject’s nervous system and shall expressly include, but not be limited to stroke, Alzheimer’s disease [...]”. Please also note that Wieloch et al. (US 6,846,641) teaches ischemic stroke as a neurodegenerative disease (See,

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e.g., column 15, lines 65-67). Therefore, the disease “ischemic stroke” reads upon both “postlesional neuronal disease due to ischemia or traumatic impact” and “neurodegenerative disease”.

### ***Double Patenting***

Claims 1-2, 5-8 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-2, 5-10 and 16 of copending Application No. 10/635,797. Although the conflicting claims are not identical, they are not patentably distinct from each other because they are drawn to overlapping subject matter, e.g., “a method for the treatment of a postlesional neuronal disease due to ischemia or traumatic impact” and “a method for the treatment of neurodegenerative diseases”, both comprising administering an effective amount of a compound of formula (I) to a human patient in need thereof. Please note that treating, e.g., “ischemic stroke” administering the instantly claimed composition of formula (I) reads upon both claimed inventions (see above). Please also note that the term “characterized by nerve cell necrosis” (as in the instantly claimed method) is a functional effect of, e.g., ischemic stroke. Therefore, the instantly claimed method encompasses and/or is encompassed by the claimed method of Application ‘797.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

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**Conclusion**

Claims 1-2, 5-8 are rejected.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcela M. Cordero Garcia whose telephone number is (571) 272-2939. The examiner can normally be reached on M-Th 7:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bruce Campell can be reached on (571) 272-0974. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Marcela M Cordero Garcia, Ph.D.  
Patent Examiner  
Art Unit 1654

MMCG 12/05



CHRISTOPHER R. TATE  
PRIMARY EXAMINER